REMARKS

Claims 1, 2, 5, 7, 9-11, 14, 16, 18, 19, and 22 have been amended. Claims 1-22 are now in the application with claims 1, 9, 10 and 18 being the independent claims. Claims 1-22 stand rejected. Rejection of these claims is respectfully traversed.

Examiner Interview

The undersigned thanks the Examiner for the time she devoted to reviewing and discussing a proposed amendment to this case. The amendments submitted herein are based on the subject matter discussed during that interview. In particular, the claims have been amended to specifically claim that the timeout condition and second web page are specified at the <u>client device</u> and not at the web server providing the web pages. This client device specification can be done by the end-user of the client device or by an administrator responsible for the client device. This provides a client side monitoring that assures that the second specified web page is displayed after a timeout regardless of the web source of the first web page. The timeout is specific to the client device and not the web application.

Rejection under 35 USC §102

Claims 1, 9, 10, 18, 3, 12, 5-6, 14-15 and 20-21 stand rejected under 35 USC §102 as being anticipated by Shuster(USP 6763379.) Rejection of these claims is respectfully traversed.

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). All limitations of the claimed invention must be considered when determining patentability. *In re Lowry*, 32 F.3d 1579, 1582, 32 U.S.P.Q.2d 1031, 1034 (Fed. Cir. 1994). Anticipation focuses on whether a claim reads on the product or process a prior art reference discloses, not on what the reference broadly teaches. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 U.S.P.Q. 781 (Fed. Cir. 1983).

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As provided in the MPEP,

> "A claim is anticipated only if each and every element as set forth
> in the claim is found, either expressly or inherently described in a
> single prior art reference." Verdegaal Bros. v. Union Oil Co. of
> California, 814 F.2d 628, 631 (Fed. Cir. 1987). "The identical
> invention must be shown in as complete detail as is contained in
> the . . . claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226,
> 1236 (Fed. Cir. 1989). The elements must be arranged as required
> by the claim, but this is not an ipsissimis verbis test, i.e., identity of
> terminology is not required. In re Bond, 910 F.2d 831 (Fed. Cir.
> 1990).

MPEP § 2131

In this case, each and every feature of the presently claimed invention is not shown in the cited reference as arranged in the claims.

Shuster is directed to a system for delivering advertising to a browser session when the session is inactive. The preferred embodiment of Shuster delivers "unsolicited data, or content, to the user computer" when a downloaded activity monitor detects a period of inactivity (Col. 4, line 43-47.) The activity monitor of Shuster is a provider based program that is downloaded to the client device (col. 4, line56-59.) The timeout of Shuster is therefore a provider specified rather than a client device specified value. Shuster fails to teach the element, "determining a first client device specified timeout condition for said browser session..."

Shuster also teaches downloading and in some cases displaying "unsolicited" data. This teaching contradicts the presently claimed element, "displaying a second client device specified web page at the client device in response to said detecting a timeout condition." Client device specified data is the opposite of unsolicited data – Shuster fails to teach this significant element of client device and user control.

Independent claims 1, 9, 10 and 18 each have these two limitations that are neither taught nor suggested by Shuster. Shuster therefore fails to teach each and every element of the claimed invention and are therefore patentable under 35 USC §102. For this reason, withdrawal of the rejection of these claims is respectfully requested.

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Claims 3, 5, 6, 12, 14, 15, 20, and 21 depend on one of the above independent claims and incorporate the limitations of the independent claim. For the reasons set forth above, it is respectfully submitted that these claims are patentable over Shuster under 35 USC §102. In addition, claims 5, 14 and 20 include a limitation of displaying the second client device specified web page in multiple browser windows in response to the timeout condition. Shuster teaches only a display of unsolicited data in a single "browser window" (col. 6, line 11.) There is no teaching or suggestion of displaying the same content in multiple windows. For this additional reason, claims 5, 14, and 20 are patentable over Shuster under 35 USC §102.

<u>Rejection under 35 USC §103</u>

Claims 2, 11, 19, 7-8, 6-17, 22, 3 and 13 stand rejected under 35 USC §103 as unpatentable over Shuster in view of Dorian *et al* (USP 6571256.) Rejection of these claims is respectfully traversed.

A determination of obviousness under 35 U.S.C. § 103 is a factual inquiry mandated in *Graham v. John Deere Co.* MPEP § 2141 (citing *Graham v. John Deere*, 383 U.S. 1 (1966)). Patent examiners bear the responsibility of making sure that the standard of patentability enunciated in *Graham v. John Deere* is applied in each and every case. MPEP § 2141. As enunciated in *Graham*, a determination of obviousness comprises a four-part factual inquiry: (1) determining the scope and content of the prior art; (2) ascertaining the differences between the prior art and the claims; (3) resolving the level of ordinary skill in the pertinent art; and (4) evaluating evidence of secondary considerations. *Id.*

The Examiner must meet three criteria to establish a *prima facie* case of obviousness. *Manual of Patent Examining Procedure* § 2142. The first element of a prima facie case of obviousness under 35 U.S.C. § 103 is that there must be a suggestion or motivation to combine the references. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). The second element of a prima facie case of obviousness under 35 U.S.C. § 103 is that there must be a reasonable expectation of success in the proposed combination of the references. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). The third element of a prima facie case of obviousness under 35 U.S.C. § 103 is that the proposed combination of the references must

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teach or suggest all of Applicants' claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974).

Applicants respectfully submit that neither Shuster nor Dorian, considered singly or in combination teach or suggest the elements of applicants presently claimed invention. For the reasons set forth above, Shuster does not teach or suggest every element of the independent claims upon which these claims depend. Nothing in Dorian teaches or suggests those missing elements. For this reason, Claims 2, 11, 19, 7, 8, 16, 17, 22, 4 and 13 are respectfully submitted to be patentable over Shuster and Dorian under 35 USC §103.

The cited dependent claims, however, have additional patentable elements that are not taught or suggested by the cited references. With respect to claims 2, 11, and 19 the Examiner argues that Dorian teaches clearing a cache database when a browsing session has ended (col. 5, lines 50-57) [Office Action, page 3.] The cache database 335 discussed in Dorian col. 5 is a server side database (see Fig. 3.) and does not teach clearing a "local cache file" as presently claimed. Clearing of the cache at the end of a browser session also does not teach or suggest clearing a local cache in response to the detecting of a client device specified timeout condition, as claimed.

The Examiner argues that the motivation to combine these references is "to enhance the privacy for users of the system." However, Shuster is focused on delivering unsolicited content (advertisements) to the user. Delivery and display of unsolicited material is inconsistent with user privacy and thus would not benefit from a privacy enhancement. Adding privacy and, in particular, cache clearing to Shuster would render that system unworkable because it would delete the unsolicited material from the cache. Thus, the Examiner has failed to meet the requirement of a reasonable expectation of success for the proposed combination.

For these additional reasons, claims 2, 11 and 19 are respectfully submitted to be patentable over the applied art.

With regard to claims 7, 16, and 22, the Examiner argues that Dorian teaches the claimed element of permitting users to specify the web pages to display in response to the timeout condition. Applicants respectfully disagree. Dorian is directed to a filtering system that permits only

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prescreened content to be viewed (Abstract.) Dorian permits entry of a number of web page names and then limits the browser to displaying only names on that list. The list of web pages is stored on a server based "account database" (Fig. 3, 340 and Fig. 1.) Dorian permits only authorized users to update this server list. The combination of Dorian and Shuster therefore fails to teach or suggest an "end-user" specification of a "client device specified" web page to be displayed upon detection of a timeout condition.

The Examiner has taken Official Notice of "receiving user input comprising a period of time used to define the timeout condition." MPEP § 2144.03 states:

> If the applicant does not seasonably traverse a claim by the
> Examiner of a well known statement during examination, then the
> object of the well known statement is taken to be admitted prior
> art. A seasonable challenge constitutes a demand for evidence
> made as soon as practicable during prosecution. Thus, an applicant
> is charged with rebutting the well known statement in the next
> reply after the office action in which the well known statement was
> made.

Applicant therefore respectfully traverses the Official Notice claimed by the Examiner in this rejection. Shuster teaches a server specified activity timer while Dorian does not discuss a timeout condition. There is no suggestion in either of accepting an end-user entered "client device specified" timeout condition. The Examiner has stated that the motivation for adding this feature is "to enable the user to determine how long the inactive time is." However, giving user control is contrary to both Shuster and Dorian. Shuster is directed to sending advertising to a browser session. Allowing the user to specify a very long activity timeout (and thus avoid unsolicited material) would frustrate the purpose of Shuster. Similarly, Dorian provides parental or similar control over the user actions on a web browser. Allowing the user rather than the parent to control activity timeouts would similarly frustrate the purposes of Dorian. The Examiner has failed to provide any independent evidence that user entry of an inactivity timeout period would have been obvious to one skilled in the art at the time of the invention. Applicants respectfully submit that the Examiner has failed to meet the burden of proof in establishing Official Notice of this element.

It is therefore respectfully submitted that the invention claimed in dependent claims 7, 16,
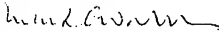
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and 22 is patentable over the applied references under 35 USC §103. Withdrawal of the rejection of these claims is respectfully requested.

Claims 4 and 13 and 8 and 17 incorporate the limitations of their independent claims and are respectfully submitted to be patentable over the applied references for the reasons set forth above.

Conclusion

It is therefore respectfully submitted that the present claims, as amended, are patentable over the cited art under 35 USC §§102 and 103. Applicants respectfully assert that all claims are now in condition for allowance and respectfully request that the outstanding rejections be withdrawn and a Notice of Allowance be issued. If the Examiner believes that a telephone conference would expedite the examination of this pending patent application, she is invited to call the undersigned attorney at the Examiner's convenience. In the event there are additional charges in connection with the filing of this Response, the Commissioner is hereby authorized to charge the Deposit Account No. 09-0451 in the amount of any necessary fee.

Respectfully submitted,
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